



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,613	05/14/2001	Peter G. Capek	YOR9-2001-0153US1 (728-20)	4824

7590 01/16/2002

Paul J. Farrell, Esq.
DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553

EXAMINER

FISCHEITTI, JOSEPH A

#3

ART UNIT	PAPER NUMBER
----------	--------------

2167

DATE MAILED: 01/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary

Application No.

09/854,613

Applicant(s)

CAPEK ET AL.

Examiner

Joseph A. Fischetti

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11,20-25 are, drawn to a method for travel services, classified in class 705, subclass 26.
- II. Claims 12-19, drawn to a computer system, classified in class 709, subclass 1+.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method can be practiced by human intervention by taking a reservation by phone and arranging for, for example, a rental car .

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Atty. Likourezos on 1/11/02 a provisional election was made without traverse to prosecute the invention of I, claims 1-11,20-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, lines 4-6, "each supplier of the collection of the at least one supplier" is indefinite because it is unclear how a collection can exist with only one supplier.

Claim 3: line 8 the combination of what? Lines 8-11 are unclear because the claim language fails to create a connection between the shipper and the selected supplier. Line 10 source location has already been recited, is this a different term?

Claim 4: on antecedent basis for transacting between supplier and item.

Claim 5: no antecedent basis for unregistered traveler

Claim 11 the term "interactive" is unclear, is applicant saying that it is providing a virtual items?

Claims 23, 24 and 25 recite improper markush groupings.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,9,10,20,21,22 are rejected under 35 U.S.C. 102(a/b) as being anticipated by Southwest Airlines web page.

Southwest airlines web page discloses a method for providing a service for travelers to acquire items at the traveler's destination comprising the steps of:

receiving a request from a traveler for obtaining at least one item at a location indicative of a destination location of the traveler (A), the request including travel data comprising the traveler's time of arrival and destination (B), and item data comprising

data indicative of items being requested (C);

arranging for the at least one item to be supplied (D);

arranging for the at least one supplied item to be delivered to the location indicated by the traveler's destination at a time indicated by the traveler's arrival time (D);

and

conducting a transaction with the traveler for the traveler to obtain the at least one item (D).

Re claim 2: for each of the at least one requested items the steps of:

accessing a collection of at least one supplier of the requested items (E,F), each supplier of the collection of at least one supplier having a location and having a collection of at least one item available for being obtained by the traveler;

selecting a supplier from the collection of the at least one supplier in accordance with availability of the item and the location of the supplier relative to the destination of the traveler (inherent in any supplier by definition is inventory location is done as a result of destination selection); and arranging for the selected supplier to supply the item.

Re claim 9: inherent in any internet based program data are images and descriptions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

qt Claims 1, 11-12, 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al.

Re claims 1-12,20-25, DeLorme et al. disclose a method for providing a service for travelers to acquire items at the traveler's destination comprising the steps of:

receiving a request from a traveler for obtaining at least one item at a location indicative of a destination location of the traveler (205), the request including

travel data comprising the traveler's time of arrival and destination (111 Fig 1a), and item data comprising data indicative of items being requested (111, Fig.1A);

arranging for the at least one item to be supplied (231);

arranging for the at least one supplied item to be delivered to the location indicated by the traveler's destination at a time indicated by the traveler's arrival time (231); and conducting a transaction with the traveler for the traveler to obtain the at least one item (209).

Re claims 3 and 4 insofar as they are definite, whether one orders from a supplier and leave to the supplier who the shipper is not deemed to be a point of patentability because it takes what is known in the art as one step order say, from Sky Mall, for example, and breaks it into two steps.

Re claim 5: registering each unregistered traveler making a request by accepting and storing personal

data and preference data about the traveler see DeLorme et al. (col.37, lines 3-66;col.35 lines9-60);

storing the request as history data (col. 36 line 14;

accessing the personal data, preference data and history data including previously stored requests of the traveler (col.39, lines 19-67); and

providing suggestion data to the traveler based on the accessed personal data, preference data and history data of the traveler, the suggestion data providing suggestions for requesting items (col. 40, lines30-56).

Re claim 6: accessing a data collection storing data about at least one geographic location see De Lorme et al. (Col. 32 lines 46-67);

retrieving data about the destination location of the traveler from the data collection about geographic locations Col. 32lines 46-67,col.33, lines 1-14); and

providing suggestion data to the traveler based on the retrieved data about the destination location of the traveler, the suggestion data providing suggestions for requesting items Col. 42 (conversation-like searching is suggestion data.)

Re claims 7 and 8: since the system disclosed by DeLorme et al. does allow for customized travel plans with a mix of arrangements, it would be obvious to include as a the input data to DeLorme et al data which is attendant to an individual's personal needs such as for example that which would be necessary for one who is visually impaired. Also, official notice is taken with respect to the old and notorious practice of air line reservationist taking data on a physical impairment and providing different meals or wheel chair service based upon the expressed impairment.

Re claim 11: official notice is taken with respect to virtual matching programs such as found in interior decorating programs.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.